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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,135	04/01/2004	Robert Salerno	DEET/0014	9633

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EXAMINER

SHAW, PELING ANDY

ART UNIT	PAPER NUMBER
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2444

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03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,135	Applicant(s) SALERNO ET AL.	
	Examiner PELING A. SHAW	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Amendment received on 11/24/2008 has been entered into record. Claims 1, 11 and 17 are amended. Claims 23-24 are cancelled. Claims 1-3 and 8-22 are currently pending.
2. Amendment received on 08/12/2008 was entered into record. Claims 4-7 were cancelled. Claims 12-24 were new.

Priority

3. This application has no priority claim made. The filing date is 04/01/2004.

Claim Rejections - 35 USC § 112, first paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 8-22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Independent claims 1, 11 and 17 are amended with the limitation of “wherein retracting the mail document comprises (i) substituting the mail document with a stub or with updated content, and (ii) deleting the mail document or removing it from the recipient’s mailbox” that is not found in the paragraphs as pointed by Applicants. It thus brings new subject to the application and is not allowed under 35 U.S.C. § 112, first paragraph. It would cause undue experimentation to one of ordinary skill in the

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art to make Applicant's invention. Other claims, i.e. claims 2-3, 8-10, 12-16 and 18-22 depend upon these claims are rejected as well for the same reason.

- b. Similarly, claim 22 recites the limitation of "wherein the step of retracting the mail document comprises deleting the mail document from the mail database" that is not found in applicant's original specification of claim set. It would cause undue experimentation to one of ordinary skill in the art to make Applicant's invention.

Claim 22 is thus rejected.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-9 and 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by authentica (MailRecall), hereinafter referred as authentica.

- a. Regarding claim 1, authentica disclosed a system for automatically and electronically retracting an electronic mail document stored in a mail database of a first Server sent from a sender to a recipient, the recipient having a mailbox, the system (page 8, 2nd and 6th paragraphs: mail server, MailRecall message; page 14, 4th paragraph: recall access after the message has been sent) comprising: a processor; and a memory, wherein the memory which includes at least: a fetch monitor at the first Server for monitoring activity on the mail document and marking the status of the mail document (page 10, 2nd paragraph: track activity; Fig. 3-4: event of read) after the mail document has been sent by the sender and when it has been received in the recipient's mailbox; a fetch control for issuing a request to retract the mail document to a fetch queue at the first Server (page 8, 6th paragraph: send a MailRecall message; Fig. 3-4, MailRecall message with icon); and a fetcher at the first Server for retrieving the request from the fetch queue (page 9, 4th paragraph: recipient receives a MailRecall protected message), retracting the mail document based on the marked status of the mail document (last paragraph on page 8 to 1st paragraph on page 9:

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- when and how to access, retracting based upon), and reporting the retraction (Fig. 4, 2nd paragraph on page 10: managing and tracking activity), wherein retracting the mail document comprises (i) substituting the mail document with a stub or with updated content, and (ii) deleting the mail document or removing it from the recipient's mailbox (3rd paragraph on page 14: expire or recall).
- b. Regarding claim 2, authentica disclosed the system of claim 1, wherein: the fetcher reports the retraction by sending a retraction report to the fetch queue; and the fetch control retrieves the retraction report from the fetch queue (page 8, 6th paragraph: send a MailRecall message; Fig. 3-4, MailRecall message with icon).
 - c. Regarding claim 3, authentica disclosed the system of claim 1 further comprising a fetch log at the first Server for receiving an event report from the fetcher (Fig. 4, 2nd paragraph on page 10: managing and tracking activity).
 - d. Regarding claim 8, authentica disclosed the system of claim 1, wherein the fetch monitor is a Domino extension manager (1st paragraph on page 6: Lotus Notes; 2nd paragraph on page 6: MIMEsceper).
 - e. Regarding claim 9, authentica disclosed the system of claim 1, wherein the fetcher is a Domino server add-in task (1st paragraph on page 6: Lotus Notes; 2nd paragraph on page 6: plug-in).
 - f. Claim 11 is of the same scope as claim 1. It is rejected for the same reasons as form claim 1.
 - g. Regarding claim 12, authentica disclosed the system of claim 1, wherein the fetcher is programmed to apply policies to determine whether the mail document is retractable,

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- and the fetcher is further programmed to retract the mail document only if retractable according to the policies (1st paragraph on page 6: manage policy).
- h. Regarding claim 13, authentica disclosed the system of claim 12, wherein the policies include policies as to read/unread status of the mail document (3rd paragraph on page 13: read receipts).
 - i. Regarding claim 14, authentica disclosed the system of claim 12, wherein the policies include policies as to age of the mail document (last paragraph on page 8 to 1st paragraph on page 9: message expire).
 - j. Regarding claim 15, authentica disclosed the system of claim 12, wherein the policies include policies as to who may initiate a request to retract the mail document (1st paragraph on page 7: user authentication).
 - k. Regarding claim 16, authentica disclosed the system of claim 12, wherein the fetcher is programmed to allow the policies to be amended by an operator or administrator of the first server (2nd paragraph on page 16: administrator configures MailRecall policy).
 - l. Claims 17-21 are of the same scope as claims 1 and 12-16. There are rejected for the same reasons as for claims 1 and 12-16.
 - m. Regarding claim 22, authentica disclosed the method of claim 17, wherein the step of retracting the mail document comprises deleting the mail document from the mail database (3rd paragraph on page 14: expire and recall).
- authentica disclosed all limitations of claims 1-3, 8-9 and 11-22. Claims 1-3, 8-9 and 11-22 are rejected under 35 U.S.C. 102(b).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over authentica and further in view of Doganata et al. (US 6728714 B1), hereinafter referred as Doganata.

- a. authentica shows claim 1 as above and (claim 10 substantially) wherein: the Server has its own means for marking the status of the mail document (Fig. 3-4: event of read) and the status is changeable by the recipient (Fig. 3-4: event of read); the user can read the mail document through preview mode without affecting the status (Fig. 3: preview pane); the user can read the mail document through HTTP without affecting the status (Fig. 3: preview pane; 2nd paragraph on page 3: Web mail; 6th paragraph on page 8: HTML message; 1st paragraph on page 10: web viewer); or the user can replicate the mail document (4th paragraph on page 16: replication). authentica does not explicitly show replicate the mail document without replicating the status. However as per page 6 of LDD Today on the History of Notes and Domino, it is shown that selective replication is a feature of Notes as of Release 3.0.
- b. Doganata shows that (column 5, lines 14-34) a mail system may not using read status in an analogous art for the purpose of assigning unique identifier to deleted unopened original sender e-mail after delivery.

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- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify authentica's functions of MailRecall to be applicable to mail system without read status as Doganata's teaching (cancelling e-mail).
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to apply recall and/or cancelling e-mail message to e-mail system including Notes and other system not supporting read status as per Doganata in the general art of recall/cancelling mail message as per authentica (front page and page 1) and Doganata (column 1, line 63-column 2, line 16)'s teaching.

Together authentica and Doganata disclosed all limitations of claim 10. Claim 10 is rejected under 35 U.S.C. 103(a).

Response to Arguments

7. Applicant's arguments filed on 11/24/2008 have been fully considered, but they are not persuasive.
- a. Applicant has pointed out paragraphs 31 and 34 in applicant's specification for the support of original claim 10. Examiner has reviewed paragraphs 31 and 34. Claim 10 does seem to have enough support from the cited paragraphs 31 and 34.
 - b. Applicant has cited Fig. 2 and paragraph 58 for the support of claim 23-24 limitations, i.e. "substituting the mail document in the mail database with a replacement mail document or with updated content" and "wherein the replacement mail document is a substantially blank document". There is no specific association of Fig. 2 with the limitations cited above. There is no teaching or suggestion that could direct one skill in the art to the practice of the limitations above. Thus the limitations are not supported by applicant's original specification and claim set.
 - c. Applicant's argument against claim rejections as per office action mailed on 10/24/2008 seem to base upon the currently amended limitation similar to ones cited above in item b. Examiner has further examiner the amended limitation of "wherein retracting the mail document comprises (i) substituting the mail document with a stub or with updated content, and (ii) deleting the mail document or removing it from the recipient's mailbox" and conclude that it is not supported, particularly as pointed out by applicant in Fig. 2 and paragraph 58 of applicant's specification.
 - d. Claim rejections are updated to reflect the current claimed invention above in section 5.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/
Examiner, Art Unit 2444